

REMARKS

Early and favorable reconsideration of this application is respectfully requested in view of the foregoing amendments and the following remarks.

In the Office Action dated July 26, 2004 (the "Final Office Action"), the Examiner made final the rejection of claims 1, 2, 5, 6 and 73 under 35 U.S.C §102(b) as anticipated by WO 91/07505 to Hornes et al. ("Hornes"); and rejected Claims 1-6, 23-32, 37, 73 and 74 under 35 U.S.C §102(e) as anticipated by U.S. Patent No. 6,610,742 to Zhu et al. ("Zhu"). In response thereto, Applicants filed a Response After Final Rejection, mailed September 23, 2004, amending some of the claims (33-36) and arguing the remaining claims were, in fact, patentable.

In the Advisory Action dated October 15, 2004 the Examiner advised that applicants' Response After Final Rejection failed to place the application in condition for allowance but would be entered for purposes of Appeal. The Examiner advised that applicants' use of "polypeptide encoding portion of a nucleic acid" was not the same as "polypeptide encoding portion of a nucleic acid" and that Claims 33-36 were allowed at this time.

Claims 1-6, 23, 24, 26-37, 73-74 and 85-96 are pending in the instant application. Applicants herein have amended Claims 1-3, 5, and 23, with the independent claims now reciting a "polypeptide encoding portion of a nucleic acid" as suggested by the Examiner, cancelled Claim 25, and added new Claims 85-96. No new subject matter has been added by these amendments. With respect to the rejection of Claims 1, 2, 5, 6 and 73 under 35 U.S.C §102(b) as anticipated by Hornes, nowhere does Hornes disclose or suggest a plasmid having a primer

sequence incorporated into the plasmid, the primer sequence being capable of annealing to at least a first portion of a polypeptide encoding portion of a nucleic acid, and a collar sequence incorporated into the plasmid, the collar sequence being capable of annealing to a second portion of the polypeptide encoding portion of the nucleic acid, as required by amended Claim 1.

As admitted by the Examiner, Hornes teaches nucleic acids engineered at their 5' and 3' ends with primer sequences having homology to the plasmid. Nowhere is there any teaching in Hornes that the plasmids utilized therein bind to the polypeptide encoding portion of a nucleic acid – the plasmids used by Hornes bind only to the engineered terminal regions, and do not bind the polypeptide encoding portion of the nucleic acid itself. To the contrary, the sequences incorporated into the presently claimed plasmids do not anneal to primer sequences engineered to the ends of the nucleic acid, they anneal to the polypeptide encoding portion of the nucleic acid. Therefore, in view of the foregoing, reconsideration and withdrawal of the rejection of Claims 1, 2, 5, 6 and 73 as anticipated by Hornes is respectfully requested.

Claims 1-6, 23-32, 37, 73 and 74 were rejected under 35 U.S.C §102(e) as anticipated by Zhu. As with Hornes, nowhere does Zhu disclose or suggest a plasmid having a primer sequence incorporated into the plasmid, the primer sequence being capable of annealing to at least a first portion of a polypeptide encoding portion of a nucleic acid, and a collar sequence incorporated into the plasmid, the collar sequence being capable of annealing to a second portion of the polypeptide encoding portion of the nucleic acid, as required by amended Claims 1 and 23.

As with Hornes, Zhu teaches nucleic acids engineered at their 5' and 3' ends with primer sequences having homology to the plasmid. Nowhere is there any teaching in Zhu that the plasmids utilized therein bind to the polypeptide encoding portion of a nucleic acid – the plasmids used by Zhu bind to the engineered terminal regions. To the contrary, the sequences incorporated into Applicants' plasmids do not anneal to primer sequences engineered to the ends of the nucleic acid encoding the polypeptide, they anneal to the polypeptide encoding portion of the nucleic acid itself. Therefore, in view of the foregoing, reconsideration and withdrawal of the rejection of Claims 1-6, 23-32, 37, 73 and 74 as anticipated by Zhu is respectfully requested.

It is believed that all the claims of the application as now presented, i.e., Claims 1-6, 23, 24, 26-37, 73-74 and 85-96, are patentably distinct over the art of record and are in condition for allowance. In view of the foregoing amendment and remarks, early and favorable reconsideration of this application is respectfully requested.

Respectfully submitted,



Michael R. Brew
Registration No. 43,513
Attorney for Applicant(s)

Carter, DeLuca, Farrell & Schmidt, LLP
445 Broad Hollow Road, Suite 225
Melville, New York 11747
Tel.: (631) 501-5700
Fax: (631) 501-3526
MRB/jjp